

Commissioner for Patents  
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**SUPPLEMENTAL/REPLACEMENT APPEAL BRIEF  
PURSUANT TO 37 C.F.R. § 41.37**

In response to the Notification of Non-Compliant Appeal Brief mailed on March 3, 2010, Applicants submit herewith a Supplemental/Replacement Appeal Brief.

In the above-identified patent application (“the present application”), Appellants filed a Notice Of Appeal on July 30, 2009 from the Final Office Action issued by the U.S. Patent and Trademark Office on March 30, 2009.

In the Final Office Action, claims 11 to 16 and 17 to 24 (*claims 16 and 17 were previously canceled and should not have been rejected by the Office*) were finally rejected.

An Amendment After A Final Office Action was mailed on June 26, 2009 (and filed on June 30, 2009), and an Advisory Action was mailed on July 16, 2009.

An Appeal Brief was filed on October 29, 2009. A Notification of Non-Compliant Appeal Brief was mailed on March 3, 2010, so that the one-month response date is April 5, 2010 (because April 3, 2010 is a Saturday).

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner, except for the Amendment After Final filed on June 30, 2009.

*The previously filed Appeal Brief filed on October 29, 2009 in support of the appeal of the final rejections of claims 11 to 16 and 17 to 24 (claims 16 and 17 were previously canceled and should not have been rejected by the Office) was deemed non-compliant in the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) of March 3, 2010. In the Notification it was stated as to item 7 that “The brief does not contain a correct copy of the appealed claims as an appendix thereto(37 CFR 41.37(c)(1)(viii)).”*

*The Replacement Appeal Brief is believed to comply with all the requirements of Rule 41.37, and to address the issues raised in Notice.*

*The Appeal Brief is believed to comply with all the requirements of Rule 41.37. It is noted that the “concise explanation” language of the Rule is like the “concise explanation” requirement of former Rule 37 CFR 1.192, and that the length of the concise explanation provided herein should therefore be acceptable, since the format was acceptable under 37 CFR 1.192 and since it specifically defines the subject matter of the relevant claims involved in the appeal. AARON C. DEDITCH (reg. no. 33,865) has filed many appeal briefs, the concise explanation for which has ultimately always been accepted by the Patent Office. **The Office is encouraged to contact the undersigned if there are any questions as to the description of the claimed subject matter.***

*It is noted that the Patent Office Rules do not require the Applicants to include references cited by and relied upon by the Examiner in the Evidence Appendix (although it is required by the Office for the Examiner). In the present Appeal, the Applicants have not submitted any evidence on which they intend to rely, so that the Evidence Appendix lists no evidence.*

It is respectfully submitted that the final rejections of pending and considered claims 11 to 16 and 17 to 24 (*claims 16 and 17 were previously canceled and should not have been rejected by the Office*) should be reversed for the reasons explained below.

**1. REAL PARTY IN INTEREST**

The real party in interest in the present appeal is Robert Bosch GmbH (“Robert Bosch”) of Stuttgart in the Federal Republic of Germany. Robert Bosch is the assignee of the entire right, title and interest in the present application.

**2. RELATED APPEALS AND INTERFERENCES**

There are no interferences or other appeals related to the present application, which “will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.”

**3. STATUS OF CLAIMS**

**CLAIMS 1 TO 10, 16, AND 17 ARE CANCELED.**

A. Claims 11 to 16, 19, 20 and 21 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent Application No. 2002/0049534 to Yuda et al., (“Yuda”), in view of U.S. Application No. 2002/0198632 to Breed et al. (“Breed”).

B. Claims 17, 18, and 22 to 24 stand rejected under 35 U.S.C. 103(a) as unpatentable over the Yuda reference, in view of the Breed reference, in further view of U.S. Application No. 6,223,125 to Hall (“Hall”).

Appellants therefore appeal from the final rejections of pending claims 11 to 16 and 17 to 24 (*claims 16 and 17 were previously canceled and should not have been rejected by the Office*). A copy of all of the pending and appealed claims 11 to 15 and 18 to 24 (claims 16 and 17 were previously canceled) is attached hereto in the Appendix.

**4. STATUS OF AMENDMENTS**

In response to the Final Office Action mailed on March 30, 2009, a Response After A Final Office Action was mailed on June 26, 2009 (and filed on June 30, 2009) in response to the Final Office Action, and an Advisory Action was mailed on July 16, 2009.

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner, except for the Amendment After Final filed on June 30, 2009.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

*The claimed subject matter is described as follows, and is directed to addressing the following problems and/or providing the following benefits, and as described in the context of the present application.*

The presently claimed subject matter relates generally to a navigational device for guiding a vehicle within a network of traffic routes. It provides, for guidance purposes, a guide object that is shown in relation to the traffic route in such a manner that the guide object's movement represents driving maneuvers to be performed by the driver. The driver emulates the driving maneuvers shown and thus follows the previously calculated route. (*See specification, e.g., Abstract*).

Independent claim 11 is to a navigational device for guiding a vehicle within a network of traffic routes. (*See specification, page 4, lines 29 to 31, and Abstract.*) The device includes a processing unit for calculating a travel route to a destination. (*See specification, page 5, lines 7 to 9; page 6, lines 7 to 8; page 9, lines 9 to 10; page 12, lines 4 to 6; and Figure 1.*) The device further includes a display for displaying a guide object. (*See specification, page 1, lines 25 to 30, and Figs. 1 to 3.*) The movement of the guide object along the calculated travel route is displayed as to a traffic route, whereby the movement of the guide object represents driving maneuvers to be performed by a driver to reach the destination. (*See specification, page 1, lines 27 to 31; page 2, lines 9 to 13; page 6, lines 26 to 30; page 10, lines 13 to 17; page 12, lines 24 to 25; and Abstract.*) The device further includes a determining arrangement to determine a traffic situation in front of the vehicle by sensing other vehicles in an area surrounding the guided vehicle. (*See specification, page 3, lines 6 to 14.*) The device further includes an adaptive controlling arrangement to adaptively control the movement of the guide object depending on the traffic situation. (*See specification, page 3, lines 6 to 17; and page 8, lines 27 to 31.*)

Independent claim 24 is to a navigational device for guiding a vehicle within a network of traffic routes. (*See specification, page 4, lines 29 to 31, and Abstract.*) The device includes a processing unit for calculating a travel route to a destination. (*See specification, page 5, lines 7 to 9; page 6, lines 7 to 8; page 9, lines 9 to 10; page 12, lines 4 to 6; and Figure 1.*) The device further includes a display for displaying a guide object. (*See specification, page 1, lines 25 to 30, and Figs. 1 to 3.*) The movement of the guide object along the calculated travel route is displayed in relation to a traffic route, in which the

movement of the guide object represents driving maneuvers to be performed by a driver of the vehicle to reach the destination. (*See* specification, page 1, lines 27 to 31; page 2, lines 9 to 13; page 6, lines 26 to 30; page 10, lines 13 to 17; page 12, lines 24 to 25; and Abstract.) The device further includes an actual highest permissible speed arrangement to determine an actual highest permissible speed at a location, (*See* specification, page 3, lines 17 to 19,) which is used to influence a velocity of the guide object so that it does not move more rapidly along the travel route than is allowed by the highest permissible speed at the location, so that the driver is deterred from exceeding the highest permissible speed. (*See* specification, page 3, lines 19 to 26.)

As to claim 13 (which depends from claim 11), it also includes the feature in which the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route in relation to the traffic route. (*See* specification, page 2, lines 15 to 19.)

As to claim 19 (which depends from claim 11), it also includes the feature in which the guide object includes a display area for displaying at least one of directional displays and warning displays associated with a driving maneuver to be performed. (*See* specification, page 3, lines 28 to 33.)

As to claim 21 (which depends from claim 11), it further includes an arrangement for representing on the display an area surrounding the traffic route. (*See* specification, page 2, line 32 to page 3, line 4.) The guide object includes a vehicle image. (*See* specification, page 6, lines 12 to 17.) Further, the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route as to the traffic route. (*See* specification, page 2, lines 15 to 19.) The display superimposes the guide object on the traffic route, within a field of view of a driver of the vehicle. (*See* specification, page 6, lines 18 to 19.)

As to claim 23 (which depends from claim 11), it further includes an arrangement for representing on the display an area surrounding the traffic route. (*See* specification, page 2, line 32 to page 3, line 4.) Further, it includes an arrangement for ascertaining a highest permissible speed, in which the ascertained highest permissible speed is used for determining the traffic situation. (*See* specification, page 3, lines 6 to 26.) The navigational device further includes an arrangement for acoustically outputting driving instructions associated with the guide object. (*See* specification, page 8, lines 24 to 25.) The guide object includes a vehicle image. (*See* specification, page 6, lines 12 to 17.) Further, the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route

as to the traffic route. (See specification, page 2, lines 15 to 19.) The display superimposes the guide object on the traffic route, within a field of view of a driver of the vehicle. (See specification, page 6, lines 18 to 19.) The guide object includes a display area for displaying at least one of directional displays and warning displays associated with a driving maneuver to be performed. (See specification, page 3, lines 28 to 33.)

Finally, the appealed claims include no means-plus-function language and no step-plus-function claims, so that 41.37(v) is satisfied as to its specific requirements for such claims, since none are present here. Also, the present application does not contain any step-plus-function claims because the method claims in the present application are not “step plus function” claims because they do not recite “a step for,” as required by the Federal Circuit and as stated in Section 2181 of the MPEP.

## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 11 to 15, 19, 20 and 21 were properly rejected under 35 U.S.C. 103(a) over the Yuda reference in view of the Breed reference.

B. Whether claims 18 and 22 to 24 were properly rejected under 35 U.S.C. 103(a) as unpatentable over the Yuda reference, in view of the Breed reference, in further view of U.S. Application No. 6,223,125 to Hall. (“Hall”).

## **7. ARGUMENTS**

### **A. REJECTIONS UNDER 35 U.S.C § 103(A) OF CLAIMS 11 to 16, 19, 20 and 21**

Claims 11 to 16, 19, 20, and 21 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent Application No. 2002/0049534 to Yuda et al., (“Yuda”), in view of U.S. Application No. 2002/0198632 to Breed et al. (“Breed”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine

reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem,” Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

### **CLAIMS 11, 12, 14, 15 & 20**

The Yuda reference concerns an apparatus for navigating a moving object for easing the action of an operator of the moving object. The apparatus has a map data acquiring section, a current position data acquiring section, an optimum route searching section for calculating an optimum route data from the map data, a forward map data acquiring section for generating a forward map data from the current position data and the optimum route data, a route navigation symbol data drawing section for generating a route navigation symbol image from the forward map data, and a stereoscopic image displaying section for displaying a three-dimensional form of the route navigation symbol image. (See *Yuda*, Abstract).

Accordingly, the Yuda reference does not disclose or suggest the claim 11 feature of a “*guide object* along the calculated travel route being displayed in relation to a traffic route, whereby the *movement of the guide object represents driving maneuvers to be performed*,” as provided for in the context of the claimed subject matter.

In this regard, the Specification of the present application specifically discloses (in view of which the claims must be interpreted) “that the driver merely needs to follow along and emulate the appropriate driving maneuvers. Thus, the *need for converting symbolic, optical displays or acoustic instructions into an active driving maneuver, is eliminated*.” (Specification, page 1, lines 30 to 31, to page 2, lines 1 to 3, emphasis added).

Any review of the Yuda reference makes clear that it does not disclose or suggest a *guide object* in which its movement represents *driving maneuvers to be performed* by a driver, as provided for in the context of the claimed subject matter. In fact, the cited section relied upon by the Final Office Action merely discusses a symbol to be generated when decisions need to be made, not a guide object to emulate its movements, since it specifically states as follows:

As the vehicle arrives *N meters before the crossroads for turning to left or right*, the route navigation symbol data generating section 23 generates a route navigation symbol data including a symbol model information for displaying “a model with blinkers and brake-lamps” and a route direction identification display information for displaying “*blinker flashing*” ... in response to the route direction data for the forward map data, indicating the direction ...

(Yuda, paragraph [0079], emphasis added).

Accordingly, the Yuda reference merely refers to a *symbol representing the vehicle to be generated when decisions need to be made* (i.e., when the vehicle N meters before the crossroads). The symbol merely indicates, given your current position, whether to turn left or right by blinkers on a symbol model representing the vehicle. In stark contrast to the claimed subject matter, the driver still needs to *convert the symbolic, optical displays and instructions into an active driving maneuver*.

For example, there is a difference between being told where to turn and following another vehicle (represented by the guide object). Thus, even if the Yuda reference informs a driver whether to turn left or right by turn-signals when decisions need to be made, this does not disclose nor suggest a *guide object representing driving maneuvers to be performed* that



the driver merely needs to follow along and emulate, as provided in the context of the claimed subject matter (and as explained in the specification).

Furthermore, Yuda does not describe or even suggest the feature of adaptively controlling the movement of the guide object *depending on the traffic situation*. In particular, a movement of the navigation symbol image with a car model, if any, depends entirely upon the *current location of the vehicle itself*. As explained above, to activate the navigation symbol image 50 of Yuda, the vehicle itself must have arrived at a certain location. (Yuda, paragraphs [0079], [0081]). Even if Yuda did refer to activation of an image of a car model in accordance with the location of the vehicle, this does not describe or suggest an arrangement for adaptively controlling the movement of the guide object *depending on the traffic information* determined by sensing other vehicles in an area surrounding the guided vehicle, as provided for in the context of the claimed subject matter.

As to the secondary Breed reference, it does not cure – and it is not asserted to cure -- this critical deficiency.

Prior art references must be considered as a whole, including portions that teach away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Furthermore, *prima facie* obviousness cannot be established based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, since there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The Breed reference teaches away from the claimed subject matter since it specifically requires communication between vehicles. In this regard, the Breed reference states as follows:

[For] the vehicle control system to function without error, certain types of information ***must*** *be accurately provided*. These include information permitting the vehicle to determine its absolute location and *means for vehicles near each other to communicate this location information to each other. ...Also, critical weather or road-condition information is necessary.*

(*Breed*, paragraph [0026], emphasis added).

In this regard, the Yuda reference does not require communication *between vehicles nor road-condition information*. Accordingly, the Breed reference teaches away from systems that do not necessitate or require communication between vehicles and road-condition information. For at least this reason it would not be obvious to combine the Yuda and Breed references, as conclusorily asserted by the Final Office Action.

Accordingly, claim 11 is allowable, as are its dependent claims 12, 14, 15, 18 and 20. Withdrawal of the obviousness rejections of claims 12, 14, 15, 18 and 20 is therefore respectfully requested.

### **CLAIM 13**

Claim 13 depends from claim 11 and is allowable for at least the same reasons as claim 11.

Still further, the subject matter of claim 13 (which depends from claim 11) further includes the feature *in which the guide object is displayed at a selected distance **in front of a current position of the vehicle** on the travel route in relation to the traffic route.* Any review of the Yuda reference makes plain that the above highlighted features are not disclosed or suggested. As to paragraph [0061], cited by the Final Office Action as assertedly disclosing these features, it does not disclose a guide object **in front of a current position of the vehicle**. Indeed, any guide object in Yuda is with respect to the current actual position of the vehicle and not in **front** of the current position, as in claim 13. In this regard, Yuda specifically states the following:

***[W]hen the vehicle arrives at the highway exit C, as shown in FIG. 5, the route navigation symbol image generating section 24 generates a route navigation symbol image 50 showing a car model with its left blinker 52 and brake lamps 53 flashing.***

(Yuda, paragraph [0081, emphasis added). Thus, navigation symbol image 50 is to the actual vehicle when it already is at a certain point and not to a guide object in front of the vehicle. Accordingly, Yuda does not disclose or suggest a guide object in front of a current position of the vehicle, let alone at a selected distance, as provided in the context of the claimed subject matter. The secondary Breed reference does not cure – and is not asserted to cure – this critical deficiency.

For at least the foregoing reasons, claim 13 is allowable. Withdrawal of the obviousness rejection of claim 13 is therefore respectfully requested.

### **CLAIM 16**

*It is respectfully submitted that the rejection of claim 16 is improper because it was previously canceled without prejudice.*

**CLAIM 19**

Claim 19 depends from claim 11 and is allowable for at least the same reasons as claim 11.

Still further, the subject matter of claim 19 (which depends from claim 11) further includes *a display area for displaying at least one of directional displays and **warning displays** associated with a driving maneuver to be performed*. The Yuda reference does not disclose or suggest the above highlighted feature. Even if the Yuda reference did refer to directional displays, these do not disclose *warning displays*, as provided for in the context of the claimed subject matter. In this regard the specification of the present application discloses the following:

[A] display of the guide object may be controlled if there is an obstacle arranged in front of the vehicle or a vehicle traveling in front of the vehicle in such a manner that the guide object is suitably delayed and made to virtually approach the obstacle at an adapted velocity. The driver, ...may then react already to this **warning display** of the guide object and adapt his/her velocity accordingly.... To aid the driver, other display fields are ... provided to warn him/her of other dangers or to display traffic signs sensed by an optical unit.

(*Specification*, page 3, lines 10 to 30, emphasis added.) Thus, the warning display of the present application warns the driver of impending dangers. In contrast, the Yuda reference merely provides navigational instructions. Accordingly, Yuda does not disclose or suggest directional displays *and warning displays* associated with a driving maneuver to be performed, as provided for in the context of claim 19 and the specification. The secondary Breed reference does not cure – and is not asserted to cure – this critical deficiency.

For at least the foregoing reasons, claim 19 is allowable. Withdrawal of the obviousness rejection of claim 19 is therefore respectfully requested.

**CLAIM 21**

Claim 21 depends from claim 11 and is therefore allowable for at least the same reasons as claim 11. Still further, the subject matter of claim 21 (which depends from claim 11) further includes features similar to those of claims 12, 13, 14, and 15 and is therefore allowable for essentially the same reasons as claims 12, 13, 14, and 15.

Withdrawal of the obviousness rejection of claim 21 is therefore respectfully requested.

**B. REJECTIONS UNDER 35 U.S.C § 103(A)  
OF CLAIMS 17, 18, and 22 to 24**

Claims 17, 18, and 22 to 24 were rejected under 35 U.S.C. 103(a) as unpatentable over the Yuda reference, in view of the Breed reference in further view of the Hall reference.

**CLAIM 17**

*It is respectfully submitted that the rejection of claim 17 is improper because it was previously canceled without prejudice.*

**CLAIM 18**

Claim 18 depends from claim 11 and is therefore allowable for at least the same reasons as claim 11 because the Hall reference does not cure – and is not asserted to cure – the critical deficiencies of the Yuda and Breed references.

Withdrawal of the obviousness rejection of claim 18 is therefore respectfully requested.

**CLAIM 23**

Claim 23 depends from claim 11 and is allowable for at least the same reasons as claim 11. Still further, the subject matter of claim 23 (which depends from claim 11) further includes features similar to those of claims 12, 13, 14, 15, 18, 19, and 20 and is therefore allowable for essentially the same reasons as claims 12, 13, 14, 15, 18, 19, and 20, since the Hall reference does not cure – and is not asserted to cure – the critical deficiencies of the Yuda and Breed references.

Withdrawal of the obviousness rejection of claim 23 is therefore respectfully requested.

**CLAIM 24**

Claim 24 includes features similar to those of claim 11 and it is therefore allowable for at least the same reasons as claim 11 because the Hall reference does not cure – and is not asserted to cure – the critical deficiencies of the Yuda and Breed references.

Withdrawal of the obviousness rejection of claim 24 is therefore respectfully requested.

As further regard the obviousness rejections, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits discussed in the specification.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Final Office Action's assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Final Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

Also, the Federal Circuit in the case of In re Kotzab made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claimed subject matter and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As also regards the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way

whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

As further regards all of the obviousness rejections, the Examiner has not provided specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully submitted that, although it has been previously requested, the Examiner has not provided an affidavit and/or published information concerning these assertions. The § 103 rejections were apparently being based on assertions that draw on facts within the personal

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knowledge of the Examiner, but no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 11 to 15 and 18 to 24 (*claims 16 and 17 were previously canceled and therefore should not have been rejected*) are allowable and the rejections should therefore be reversed.

### **CONCLUSION**

In view of the above, it is respectfully requested that the rejections of claims 11 to 16 and 17 to 24 be reversed (*claims 16 and 17 were previously canceled and therefore should not have been rejected*), and that these claims be allowed as presented.

Respectfully submitted,

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**CLAIMS APPENDIX**

1-10. (Canceled).

11. A navigational device for guiding a vehicle within a network of traffic routes, comprising:

a processing unit for calculating a travel route to a destination;

a display for displaying a guide object, a movement of the guide object along the calculated travel route being displayed in relation to a traffic route, whereby the movement of the guide object represents driving maneuvers to be performed by a driver of the vehicle to reach the destination;

a determining arrangement to determine a traffic situation in front of the vehicle by sensing other vehicles in an area surrounding the guided vehicle; and

an adaptively controlling arrangement to adaptively control the movement of the guide object depending on the traffic situation.

12. The navigational device of claim 11, wherein the guide object includes a vehicle image.

13. The navigational device of claim 11, wherein the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route in relation to the traffic route.

14. The navigational device of claim 11, wherein the display is configured to superimpose the guide object on the traffic route, within a field of view of a driver of the vehicle.

15. The navigational device of claim 11, further comprising:

an arrangement for representing on the display an area surrounding the traffic route.

16-17. (Canceled).

18. The navigational device of claim 11, further comprising:

an arrangement for ascertaining a highest permissible speed, wherein the ascertained highest permissible speed is used for determining the traffic situation.

19. The navigational device of claim 11, wherein the guide object includes a display area for displaying at least one of directional displays and warning displays associated with a driving maneuver to be performed.

20. The navigational device of claim 11, further comprising:

an arrangement for acoustically outputting driving instructions associated with the guide object.

21. The navigational device of claim 11, further comprising:

an arrangement for representing on the display an area surrounding the traffic route;  
wherein the guide object includes a vehicle image,  
wherein the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route in relation to the traffic route, and  
wherein the display is configured to superimpose the guide object on the traffic route, within a field of view of a driver of the vehicle.

22. The navigational device of claim 11, further comprising:

an arrangement for ascertaining a highest permissible speed, wherein the ascertained highest permissible speed is used for determining the traffic situation; and  
an arrangement for acoustically outputting driving instructions associated with the guide object;  
wherein the guide object includes a display area for displaying at least one of directional displays and warning displays associated with a driving maneuver to be performed.

23. The navigational device of claim 11, further comprising:

an arrangement for representing on the display an area surrounding the traffic route;  
an arrangement for ascertaining a highest permissible speed, wherein the ascertained highest permissible speed is used for determining the traffic situation; and

an arrangement for acoustically outputting driving instructions associated with the guide object;

wherein the guide object includes a vehicle image,

wherein the guide object is displayed at a selected distance in front of a current position of the vehicle on the travel route in relation to the traffic route,

wherein the display is configured to superimpose the guide object on the traffic route, within a field of view of a driver of the vehicle, and

wherein the guide object includes a display area for displaying at least one of directional displays and warning displays associated with a driving maneuver to be performed.

24. A navigational device for guiding a vehicle within a network of traffic routes, comprising:

a processing unit for calculating a travel route to a destination;

a display for displaying a guide object, a movement of the guide object along the calculated travel route being displayed in relation to a traffic route, wherein the movement of the guide object represents driving maneuvers to be performed by a driver of the vehicle to reach the destination; and

an actual highest permissible speed arrangement to determine an actual highest permissible speed at a location, wherein the highest permissible speed is used to influence a velocity of the guide object so that it does not move more rapidly along the travel route than is allowed by the highest permissible speed at the location, so that the driver is deterred from exceeding the highest permissible speed.

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EVIDENCE APPENDIX

Appellants have not submitted any evidence pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, and do not rely upon evidence entered by the Examiner.

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RELATED PROCEEDINGS INDEX

There are no interferences or other appeals related to the present application.